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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,555	02/19/2002	Masashi Watanabe	02097/LH	9145

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NEW YORK, NY 10001-7708

EXAMINER

SINGH, SATWANT K

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/079,555

Applicant(s)

WATANABE, MASASHI

Examiner

Satwant K. Singh

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 8 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 September 2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 8, and 12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori (US 2004/0174559).

5. Regarding Claim 1, Mori discloses a facsimile apparatus (Fig. 2, network facsimile device FX) comprising: a communication section which performs image

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data communication utilizing a mail transmission system of a computer network (LAN I/F 12) (page 3, paragraph [0048]); a printer (plotter 6) (page 3, paragraph [0044]); a determining section which, if a delivery confirmation mail, which notifies whether delivery of image data has succeeded or failed, has arrived, determines whether the delivery confirmation mail notifies a delivery failure or a delivery success of the image data transmitted from the communication section (delivery confirming mail) (pages 3 and 4, paragraphs [0051] – [0055]); and a control section which causes the printer to print an image based on the delivery confirmation mail, only if the determining section has determined that the delivery confirmation mail notifies the delivery failure and which causes the printer not to print an image based on the delivery confirmation mail if the determining section has determined that the delivery confirmation mail notifies the delivery success (delivery confirming mail is recorded and outputted only when the contents indicate a delivery failure ) (page 6, paragraph [0095] and page 7, paragraph [0114]).

6. Regarding Claim 2, Mori discloses a facsimile apparatus, comprising: an acceptance section which accepts user designation as to whether or not the delivery confirmation mail is requested, if the user requests transmission of the image data; and a request section which causes the communication section to perform transmission of the image data with the request of the delivery confirmation mail, in response to the acceptance section accepting the user designation that the delivery confirmation mail is requested, wherein the control section causes the printer to print the image based on the delivery confirmation

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mail regardless of a determination result of the determining section, if the delivery confirmation mail has arrived in response to the transmission of the image data with the request of the delivery confirmation mail performed under control of the request section (user can designate whether contents of the delivery confirmation mail are recorded and outputted) (page 6, paragraph [0110]).

7. Regarding Claim 3, Mori discloses a facsimile apparatus, wherein the communication section transmits an e-mail, to which image data is attached as an attachment file, based on an e-mail protocol (communication protocols) (page 3, paragraph [0039]).

8. Regarding Claim 8, Mori discloses a method of controlling a facsimile apparatus including a printer and a communication section which performs image data communication utilizing a mail transmission system of a computer network, the method comprising: determining, if a delivery confirmation mail, which notifies whether delivery of image data has succeeded or failed, has arrived, whether the delivery confirmation notifies a delivery failure or a delivery success of the image data transmitted from the communication section (delivery confirming mail) (pages 3 and 4, paragraphs [0051] – [0055]); and causing the printer print an image based on the delivery confirmation mail, only if it has been determined that the delivery confirmation mail notifies the delivery failure, and causing the printer not to print an image based on the delivery confirmation mail, if the it has been determined that the delivery confirmation mail notifies the delivery success (delivery confirming mail is recorded and outputted only when the contents

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indicate a delivery failure ) (page 6, paragraph [0095] and page 7, paragraph [0114]).

9. Claims 10 and 13 are rejected for the same reason as claim 2.
10. Claims 11 and 14 are rejected for the same reason as claim 3.
11. Claim 12 is rejected for the same reason as claim 1.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sugawara et al. (US 2006/0064460) disclose an Internet facsimile apparatus to provide means for notifying the user of details of a message disposition notification situation (MDN) of a transmission image.

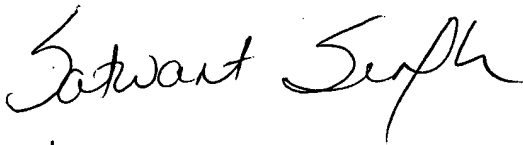
### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

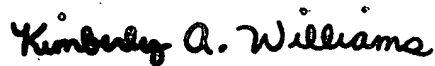
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



sks

Satwant K. Singh  
Examiner  
Art Unit 2625



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER